UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/695,639	OKADA ET AL.
Office Action Summary	Examiner	Art Unit	
	KIMBERLY EVANS	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 May 2008</u>.

2a) ☒ This action is FINAL.　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>28 October 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments

1. This action is in reply to the response filed on May 27, 2008.

2. Acknowledgement is made that the applicant has amended claims 1-16 and has added (new)
    claim 17.

3. Claims 1-17 are currently pending and have been examined.

4. The rejections of claims 1-16 have been updated to reflect the amendments.

5. The Examiner has carefully reviewed the Applicant's response and has determined that the
    rejection stands and is resubmitted below addressing the claims as modified by said
    amendments.

Claim Rejections - 35 USC § 112- 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

    The specification shall contain a written description of the invention, and of the manner and
    process of making and using it, in such full, clear, concise, and exact terms as to enable any
    person skilled in the art to which it pertains, or with which it is most nearly connected, to make
    and use the same and shall set forth the best mode contemplated by the inventor of carrying out
    his invention.

7. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the
    written description requirement. The claim(s) contains subject matter which was not described in
    the specification in such a way as to reasonably convey to one skilled in the relevant art that the
    inventor(s), at the time the application was filed, had possession of the claimed invention. Claims
    1 and 8 contain "plurality of combinations between a location identifier and the URL (Uniform
    Resource Locator) of a Web site providing a service for a purchase request of a consumable item
    used in the printer in the corresponding location..." which was not properly identified or described
    in the original specification, and is considered new matter. The dependent claims do not remedy

this flaw. (New) claim 17 describes "…the receiving process obtains a country information set in an operating system, and displays a list of locations indicated in the obtained country information as a subject of a selection before receiving a selection of the location where the printer is used…" this was not properly identified or described in the original specification.

The added material which is not supported by the original disclosure is as follows:

    i.   The newly recited claim limitation "…<u>a plurality of combinations between a location identifier and the URL (Uniform Resource Locator) of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location</u>…" within claim 1, and similarly in claim 8 "…<u>a plurality of combinations between a location identifier and the URL (Uniform Resource Locator) of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location</u>…" appears to constitute new matter.

    ii.   The newly added claim 17 which recites "…<u>the receiving process obtains a country information set in an operating system, and displays a list of locations indicated in the obtained country information as a subject of a selection before receiving a selection of the location where the printer is used</u>…." also appears to constitute new matter.

    iii.   In particular, Applicant does not point to, nor was the Examiner able to find, any support for the newly added claim language or language to support claim 17 within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

    rejections set forth in this Office action:

    A patent may not be obtained though the invention is not identically disclosed or described as set

    forth in section 102 of this title, if the differences between the subject matter sought to be

    patented and the prior art are such that the subject matter as a whole would have been obvious

    at the time the invention was made to a person having ordinary skill in the art to which said

    subject matter pertains. Patentability shall not be negatived by the manner in which the invention

    was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),

    that are applied for establishing a background for determining obviousness under 35

    U.S.C. 103(a) are summarized as follows:

    a. Determining the scope and contents of the prior art.

    b. Ascertaining the differences between the prior art and the claims at issue.

    c. Resolving the level of ordinary skill in the pertinent art.

    d. Considering objective evidence present in the application indicating obviousness or

        nonobviousness.

10. Claims 1-5, 7, 8, 9, 11, 12-14 and 16 are rejected as being unpatentable over Haines et al, US

    Patent No 7,043,523 in view of Walker et al, US Patent No 6,494,562 B1.

11. With respect to Claims 1, 8, and 12:

    Haines discloses the following limitations:

    - *a receiving process which receives from a user an input of a location where said printer is*

      used (referring to Figure 4, see at least column 9, lines 53-65: "...maintainer 251 interacts*

database 211 to determine when to replace consumables, what consumables to replace, alternative parts for peripheral devices, issue urgency, pro-active warning of next issue(s), printer location and owner/contact information, printer model, serial number, etc., and impending maintenance notification...." and column 7, lines 18-20:"...maintainer comprises an individual whose job is to care for, maintain and feed (or replenish) a computer peripheral device...")

- *an obtaining process which obtains information regarding a consumption degree of the consumable item used in the printer* (see at least column 8, lines 8-11: "...more users 48 of PC 12 interact with peripheral device 14 to obtain information on consumable levels, media levels and types...and referring to figure 3, column 8 lines 63-66: "...users 48 bi-directionally interact with devices 14, 114, and 214 to obtain consumable levels, media levels and types, warnings and/or notifications....")

- *an accessing process which accesses a Web site where the consumable item is purchasable, the Web site being identified by said URL thus stored, when the consumption degree meets a standard which is obtained by a predetermined rule* (see at least column 6, lines 29-42: "...The consumable order-assistance system then prompts the user using the printer driver 25 (see FIG. 1), or the user is notified during the print job that the printer is running low of toner. During such notification, the system indicates the part number of the consumable and provides a uniform resource locator (URL), which enables the user to place an order via the PC and through the Internet with the reseller of the consumable. The user merely needs to click on the URL in order to cause the transfer of electronic shopping cart data list 38 to electronic shopping cart 138 (see FIG. 1). The shopping cart is then filled with the consumable information that needs to be ordered, and the user merely needs to check out of the reseller's website...")

Haines discloses all of the above limitations, Haines does not disclose the following limitations, but Walker however as shown discloses:

- a *storing process which stores a URL (Uniform Resource Locators) being associated with said location in the input thus received, with reference to data where a plurality of combinations between a location identifier and the URL of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location are associated with each other in advance* (see at least Figures 1,2,4,and 6, column 1, lines 65-67: "…Each sales channel typically includes one or more distributors and a reseller or service provider…"; column 3, lines 9-17: "…The printing system 10 includes a printer portion 12 having one or more replaceable printing components 14 installed therein… Each printing component 14 includes a sales channel or reseller identification device 16 for storing information identifying a reseller or service provider of the printing system 10 for use in ordering replacement replaceable printing components 14…"; Figure 4, column 7, lines 34-43: "... FIG. 4 is a representation of the contents of the electrical storage device 42 within the reseller identification device 16. The electrical storage device 42 includes a plurality of information storage locations, each having a corresponding memory address... For example, in memory location 0000, component identifier information is stored, and in location 0001, reseller identification information is stored..."; Figure 6, column 8 lines 40-57: "…FIG. 6 is a flow diagram illustrating the method of the present invention for storing reseller information in the replaceable printing component 14. The process begins by the manufacture of the replaceable printing component 14 as represented by step 72. The manufacturer then writes default information into the replaceable printing component 14 as represented by step 74. The manufacturer 64 makes use of a device such as the reseller programming device 26 shown in FIG. 2 to store this default information in the replaceable printing component 14. This default information may specify a list of resellers 68 that sell the replaceable printing component 14 or this default information may identify a particular reseller 68 that is to receive the replaceable printing component 14. Alternatively, this default information may specify a web address or a URL which points to the reseller 68 or which points to information which the customer can then use to determine the reseller 68 of the replaceable printing component

14…"; column 8, lines 62-64: "…The final reseller 68 then stores the reseller identification information to the printing component 14 as represented by step 80. The reseller identification is any information that is suitable for identifying the sales channel or specific members of the sales channel such as resellers 68, intermediate channel 66 or manufacturer 64…"; column 9, lines6-8: "…The final reseller 68 then sells the replaceable printing component 14 to the customer 70 as represented by step 82…")

It would have been obvious to one ordinary skilled in the art at the time of the invention to combine the consumable order-assistance system of Haines with the replaceable printing component and electrical storage device of Walker because this would provide an incentive for the reseller to carry a particular brand over other brands and would be a more efficient means for receiving distributor, reseller and/or service provider information as it relates to replaceable printing components manufactured or distributed under different brands while also providing an effective means for storing the information.

12. With respect to Claims 2, and 13,

Haines and Walker disclose all of the above limitations, Haines further discloses,

- *said accessing process which accesses the Web site where the consumable item is purchasable is performed by an instruction from a user* (see at least column 5 lines 15-18: "…in one case, program 30 is designed to prompt a customer, or user, of PC 12 for authorization information before submitting an order for at least one consumable via Internet 23 with reseller 24.." and referring to figure 1, column 6 lines 35 & 36: ...enables the user to place an order via the PC and through the Internet with the reseller of the consumable and column 4 lines 25-30: "…electronic shopping cart data list 38 which provides a pre-formatted arrangement of data for an electronic shopping cart 138 within a web site of provider 24…")

13. With respect to Claim 3,

Haines and Walker disclose all of the above limitations, Haines further discloses:

- *said program allows the computer to execute said receiving process which receives from the user the input of the location where said printer is used,* (referring to Figure 4b, see at least column 9, lines 53-65: "…maintainer 251 interacts database 211 to determine when to replace consumables, what consumables to replace, alternative parts for peripheral devices, issue urgency, pro-active warning of next issue(s), printer location and owner/contact information, printer model, serial number, etc., and impending maintenance notification….")

- *said storing process which stores the URL being associated with the location in the input thus received, at a time when said program is installed* (see at least Figure 1, column 5, lines 37-39: "…system 10 is changed to accommodate the complexity of the environment where system 10 is to be installed…"; column 6 lines 24-26: "…an end user interface 110 is provided comprising an end user interaction piece which forms the interface for a consumable order-assistance system 10 (see FIG. 1)…"; lines 33-36: "…the system indicates the part number of the consumable and provides a uniform resource locator (URL), which enables the user to place an order via the PC and through the Internet with the reseller of the consumable…"; lines 66-67: "…A centralized order-assistance tool was installed within environment 300…")

14. With respect to Claim 4,

Haines and Walker disclose all of the above limitations, Haines further discloses:

- *said program allow the computer to execute a process for receiving an input of the URL, instead of said receiving process which receives from the user the input of a location where said printer is used, and allows the computer to execute a process for storing the URL thus received, instead of said storing process which stores the URL being associated with the location in the input thus received.* (see at least Figure 1 column 6, lines 29-42: "…The consumable order-assistance system then prompts the user using the printer driver 25 (see FIG. 1), or the user is notified during the print job that the printer is running low of toner. During such notification, the system indicates the part number of the consumable and

provides a uniform resource locator (URL), which enables the user to place an order via the PC and through the Internet with the reseller of the consumable. The user merely needs to click on the URL in order to cause the transfer of electronic shopping cart data list 38 to electronic shopping cart 138 (see FIG. 1). The shopping cart is then filled with the consumable information that needs to be ordered, and the user merely needs to check out of the reseller's website...")

15. With respect to Claims 5, 9, and 14,

Haines and Walker disclose all of the above limitations, Haines further discloses:

- *said receiving process which receives from the user the input of the location where said printer is used displays the location in selectable manner, based on said data where the location and the URL (Uniform Resource Locators) are associated with each other in advance* (referring to Figure 1, column 4, lines 21-30: "...messaging system 28 comprises an email application program 36. Additionally, consumable order assistance computer program 30 comprises an electronic shopping cart data list 38 which provides a pre-formatted arrangement of data for an electronic shopping cart 138 within a web site of provider 24. Data list 38 formats data that is needed to fill in shopping cart 138, such as order information identifying a consumable and order location information for the consumable..."; column 5, lines 37-39: "...system 10 is changed to accommodate the complexity of the environment where system 10 is to be installed..."; Figure 4b, column 6 lines 64-66:"...a professional information technology (IT) department is shown....a centralized order-assistance tool was installed with environment 300...and column 7 lines 7-11: "...the notification includes information on which consumables need to be replenished...and locations where the purchaser can place an order for the consumables...for example an electronic URL link....")

16. With respect to Claims 7, 11, and 16:

Haines and Walker disclose all of the above limitations, Haines further discloses:

- *said consumable item is an ink cartridge, and the consumption degree of said consumable item is expressed by an ink remaining amount* (see at least column 1, lines 55 and 56: "…toner supply cartridges, ink, and ink reservoirs…and column 2 lines 30-34:…a computer-implemented self-adjusting consumable order-assistance system is provided which implements a program in which consumable components of computer peripheral devices are replenished…and lines 29-32 as noted in example given, "…the consumable order-assistance system then prompts the user using the printer driver 25 (see Figure 1), or the user is notified during the print job that the printer is running out of toner….and column 8 lines 15-25: …Decision maker 50 interacts with peripheral device to determine when to replace consumables…what consumables to replace…usage and/or depletion rate…")

17. Claims 6, 10, 15, and 17 are rejected as being unpatentable over Haines et al, US Patent No 7,043,523 in view of Walker et al, US Patent No 6,494,562 B1 in view of Brewster et al US Patent No 7,065,497 B1.

18. With respect to Claims 6, 10, and 15:

   Haines and Walker disclose all of the above limitations; Haines further discloses the following,

   - *said receiving process which receives from the user the input of the location where said printer is used* (see at least column 6, lines 10-17: "…TopTools comprises a web-based tool that helps a user or administrator manage computer assets, upgrade PC BIOS and drivers, manage network devices and printers, and keep track of network resources and performance. Based on industry standards such as DMI, SNMP, WMI, TCP/IP and HTTP, TopTools will increase efficiency by providing immediate device status from any location in a computer environment….."; column 7, lines 46-52: "…Such action is similar to a printer finding a dynamic host configuration protocol (DHCP) server in order to receive an Internet protocol (IP) address or a Jet or JetAdmin Discovery printer devices on the network…"; column 9, lines 53-58: "…Maintainer 251 interacts with database 211 to determine when to

replace consumables, what consumables to replace, alternative parts for peripheral devices, issue urgency, pro-active warning of next issue(s), printer location and owner/contact information, printer model, serial number, etc., and impending maintenance notification...")

Haines and Walker disclose all of the above limitations, the combination of Haines and Walker does not disclose the following limitations, but Brewster however as shown discloses:

- *execute a process which obtains country information set in said computer, displays the location under a condition that a country corresponding to the country information thus obtained is being selected* (see at least Figure 6, column 4, lines 57-64: "...In this program, only three pieces of information are stored in the user profile: type of printer, email address, and whether HP can contact the user or not. FIG. 6 shows a more complicated user profile than that currently used in HP's Instant Delivery Program, which includes the user's name, email address, company name, city, state, country, zip or postal code, phone number, printer information, and areas of interest...")

It would have been obvious to one ordinary skilled in the art at the time of the invention to combine the consumable order-assistance system of Haines and the replaceable printing component and electrical storage device of Walker with the Document Delivery System of Brewster because this would provide a more detailed user (printer) profile making acquisition of the consumable component a more efficient process.

19. With respect to Claim 17,

Haines, Walker, and Brewster disclose all of the above limitations, Haines further discloses:

- *displays a list of locations indicated in the obtained country information as a subject of a selection before receiving a selection of the location where the printer is used* (see at least Figures 4A and 4B, column 6, lines 10-19: "...TopTools comprises a web-based tool that helps a user or administrator manage computer assets, upgrade PC BIOS and drivers, manage network devices and printers, and keep track of network resources and

performance. Based on industry standards such as DMI, SNMP, WMI, TCP/IP and HTTP, TopTools will increase efficiency by providing immediate device status from any location in a computer environment. Such tools are typically used by a formal system or network administrator, such as someone who holds the title of network administrator…"; column 6, lines 66-67 thru column 7, lines 1-2: "…a centralized order-assistance tool was installed within environment 300 wherein interactions at an end user level and an embedded web server (EWS) level are rendered in the form of an operating system…"; column 7, lines 26-28: "…a consolidated email is generated once per day listing all the printers within the environment that need attention within the next upcoming day…")

Haines and Walker disclose all of the above limitations, the combination of Haines and Walker does not disclose the following limitations, but Brewster however as shown discloses:

- *the receiving process obtains a country information set in an operating system* (see at least Figure 6, column 4, lines 57-64: "…In this program, only three pieces of information are stored in the user profile: type of printer, email address, and whether HP can contact the user or not. FIG. 6 shows a more complicated user profile than that currently used in HP's Instant Delivery Program, which includes the user's name, email address, company name, city, state, country, zip or postal code, phone number, printer information, and areas of interest…")

It would have been obvious to one ordinary skilled in the art at the time of the invention to combine the consumable order-assistance system of Haines and the replaceable printing component and electrical storage device of Walker with the Document Delivery System of Brewster because this would provide a more detailed user (printer) profile making acquisition of consumable components a more efficient process.

Response to Arguments

20. Applicant's arguments with respect to independent claims 1, 8, 12, and 17 have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's arguments with respect to dependent claims 2-7, 9-11, and 13-16 have been considered but are also moot in view of the new ground(s) of rejection.

22. Applicant's arguments received on May 27, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed May 27, 2008.

23. With regard to limitations of claims 1 and 8, on page 9 of the Remarks, Applicant broadly states that "...Haines et al., do not show or suggest a plurality of combinations between a location identifier and the URL (Uniform Resource Locator) of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location associated with each other in advance...". In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Haines, Walker, and/or Brewster based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action, and in the prior Office Action incorporated herein.

24. With regard to Claim 17, on page 11 of the Remarks, Applicant broadly states that "Haines et al. do not show or suggest this limitation also..." In response, all of the limitations which Applicant disputes as missing in the applied reference is fully disclosed or obvious in view of the collective teachings of Haines, Walker, and/or Brewster base on the logic of one ordinarily skilled in the art. Detailed explanations are given in the preceding sections of the present Office Action.

25. In addition, in response to Applicant's argument that the reference fails to show certain features of Applicant's invention, it is noted that the features upon which applicant relies:

     i. "..a plurality of combinations between a location identifier and the URL (Uniform Resource Locator) of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location..." within claim 1, and similarly in claim 8 "...a plurality of combinations between a location identifier and the URL (Uniform Resource Locator) of a Web site providing a service for a purchase request of a consumable item used in the printer in the corresponding location..." appears to constitute new matter.

     ii. "...the receiving process obtains a country information set in an operating system, and displays a list of locations indicated in the obtained country information as a subject of a selection before receiving a selection of the location where the printer is used...." also appears to constitute new matter.

are not recited in the original specification or originally filed claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van "Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner hereby identifies "a plurality of combinations between a location identifier and the URL...." as identified in claims 1, 8, and 12; and "displays a list of locations indicated in the obtained country information as a subject of a selection before receiving a selection of the location where the printer is used..." as recited in claim 17 <u>as new matter</u> since the specification as originally written does not support the newly added claim and/or claim language.

Conclusion

26. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L.**

Evans whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

28. /KIMBERLY EVANS/Examiner, Art Unit 3629

September 15, 2008

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629